

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTORS: Barbara Chabut and Wen-Feng Liu

APPLICATION NO. 10/679,871

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Examiner: Robert E. Seller

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Group Art Unit: 1712

TITLE: VINYL ESTER ADHESIVE COMPOSITIONS

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MAIL STOP: APPEAL BRIEF-PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

CONSIDERED: /R.S./

Attention: Board of Patent Appeals and Interferences

09/22/2008

APPELLANTS' REPLY BRIEF

This Reply Brief is in response to the Examiner's Answer mailed July 11, 2008.

1. STATUS OF THE CLAIMS

- A. Claims cancelled: 2-5, 16-45
- B. Claims withdrawn from consideration but not cancelled: None
- C. Claims pending: 1, and 6-15.
- D. Claims allowed: None
- E. Claims objected to: None.
- E. Claims rejected: 1, and 6-15.
- F. Claims appealed: 1, and 6-15.

2. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

Appellants request that the Board overturn the rejection under 35 U.S.C. §103(a) of claims 1 and 6 to 15 as allegedly being obvious over European Patent No. 199,671 (EP '671) and Japanese Patent No. 2001-89716 (JP '716) in view of U.S. Patent No. 4,729,696 to Goto *et al.* (Goto) and further in view of U.S. Patent No. 5,891,942 to Parish *et al.* (Parish).

3. ARGUMENTS

Appellants request that the Board overturn the Examiner's rejection of claims 1 and 6 to 15. Despite the Appellants argument to the contrary, the Examiner continues to reject these claims as allegedly being obvious over EP '671 and JP '716 in view of Goto and further in view of Parish.

The pending claims are directed, in part, to a curable composition for anchoring materials in or to concrete, wherein the composition comprises, among other elements, a reactive diluent that is substantially styrene free. Appellants have found that the claimed compositions possess unexpectedly superior pull out performance at relatively high temperatures.

The Examiner acknowledges, albeit indirectly, that the embodiments exemplified in EP '671 and JP '716 support Appellants' argument that such embodiments are **NOT** substantially styrene free. (*Examiner's Answer*, p. 4, "The exemplified reactive thinner of [EP '671] and monofunctional monomer of [JP '716] is styrene which contradicts the claimed reactive diluent being substantially styrene-free.") However, despite clear teachings of these items, the Examiner has taken an expansive and overly broad reading of these references as teaching "**any** reactive thinner or monofunctional monomer which achieves the desired viscosity." (*Examiner's Answer*, p. 4, emphasis added.) Such an interpretation is without factual support or reasoned justification. There is simply nothing in either of these references that would teach or suggest that the choice of reactive diluent is without limitation as the Examiner argues. Moreover, even if, arguendo, the references taught thinners generically, they still do not teach the styrene-free species of diluents presently claimed. Appellants also point out that the argument that the Examiner now makes on appeal contracts his earlier reasoning for withdrawing anticipation rejections in view of

these references. (Final Office Action, dated 7/11/2008, p. 2, “102(b) rejection over [EP ‘671] and [JP ‘716] is rescinded due to the lack of recitation of the claimed species in component b [i.e., reactive diluent].”) Accordingly, Appellants urge the Board to consider these references in view of their actual teachings and not the overly board interpretation suggested by the Examiner.

With respect to the Examiner’s reliance on Goto, Appellants note that Goto teaches a curable adhesive comprising a polyfunctional epoxy resin in combination with a reactive monomer. But unlike the claimed invention, the polyfunctional epoxy resins of Goto are particularly well suited to form a resin with styrene. In fact, Goto explicitly states that, with respect to reactive monomers, “[s]tyrene is particularly preferred.” Col. 5, lines 66 – 67. In view of Goto’s teaching of the advantages of styrene over other possible reactive monomers, any suggestion that Goto teaches the desirability of the Office’s proposed modification (i.e., a substantially styrene free diluent) is untenable. The teachings of Goto, when taken as a whole, suggest combining the claimed polymerizable vinyl ester with styrene – a combination which applicants have found is actually disadvantageous. Since Goto teaches away from the claimed invention, the Examiner’s assertion that Goto acts as “a bridge for using the vinyltoluene of Parish et al. in the formulation of [EP ‘671] and [JP ‘716]” is without merit. (*Examiner’s Answer*, p. 8)

With respect to the Examiner’s reliance on Parish, Appellants note that Parish teaches a *sprayable coating* having improved water resistance comprising a resin and vinyl toluene. The art of Parish, therefore, is substantially different that the art of the present claim and the other references, i.e., *compositions for anchoring an article into concrete*. For this reason alone, the Examiner’s reliance on Parish, even as a secondary reference, is misplaced.

Equally without merit is the Examiner's bald assertion that one skilled in the art, at the time of the invention, would have known to apply styrene free diluents to the epoxy resin of the claimed composition in view of Parish. The diluents of Parish are designed for use with an acrylate or methacrylate resin. The Examiner has provided no factual evidence or reasoned justification to support his position that the combination of acrylate or methacrylate resins and styrene-free reactive diluents are comparable to the combination of epoxy resins and styrene-free reactive diluents of the present claims. Instead of relying on any rationale basis found in the prior art, the Examiner has cherry picked certain elements from unrelated references and then combined them based upon the framework set forth in the present application to suit his argument. As such, the Examiner has not met his burden for establishing a *prima facie* case of obviousness.

Accordingly, Appellants request that the Board reverse the Examiner's rejection of the claims.

Respectfully submitted,

September 11, 2008

Date

/Joseph Posillico/

Joseph F. Posillico

Reg. No. 32290

Fox Rothschild LLP

1101 Market Street, Ste. 2600

Philadelphia, PA 19107

Telephone: 215-923-4466

Facsimile: 215-923-2189